REMARKS/ARGUMENTS

Claims 7-22 are pending in this application. By this Amendment, Applicant amends Claim 7.

Claims 7-9, 14-16, 18, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nakakubo et al. (U.S. 6,140,891). Claims 10 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakakubo et al. in view of Brown (U.S. 4,578,736). Claims 11-13 and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakakubo et al. Applicant respectfully traverses the rejections of Claims 7-22.

Claim 7 has been amended to recite:

> A surface mountable device comprising;
> a substrate including a first principal surface, a second principal surface, and a side surface connecting the first principal surface to the second principal surface;
> a terminal electrode disposed on the first principal surface; and
> a first conductor for appearance inspection extending continuously from the terminal electrode to the side surface and having a width less than a width of the terminal electrode; wherein
> **the terminal electrode is arranged to be directly connected to a land on a mother board via solder**; and
> **the first conductor for appearance inspection is arranged such that the solder connecting the terminal electrode to the land extends from the terminal electrode onto the first conductor for appearance inspection**. (emphasis added)

The Examiner alleged that Nakakubo et al. teaches all of the features recited in Applicant's Claim 7, including a terminal electrode 14 disposed on a first principal surface of a substrate 1, 2, 3, 4, 5, and a first conductor 16 for appearance inspection extending continuously from the terminal electrode 14, wherein the first conductor 16 has a width less than a width of the terminal electrode 14.

Element 14 of Nakakubo et al., which the Examiner alleged corresponds to the terminal electrode recited in Applicant's Claim 7, is disclosed as being a shield electrode and element 16 of Nakakubo et al., which the Examiner alleged corresponds to the first conductor for appearance inspection recited in claim 7, is disclosed as being a connection electrode. That is, the structure and arrangement of the shield electrode 14

and the connection electrode 16 of Nakakubo et al. are clearly very different from the terminal electrode and the first conductor for appearance inspection, respectively, as recited in Applicant's Claim 7.

In order to more clearly distinguish Applicant's claimed invention over the applied prior art, Applicant's Claim 7 has been amended to recite the features of "the terminal electrode is arranged to be directly connected to a land on a mother board via solder" and "the first conductor for appearance inspection is arranged such that the solder connecting the terminal electrode to the land extends from the terminal electrode onto the first conductor for appearance inspection." Support for these features is found, for example, paragraphs [0041] and [0045] of Applicant's Substitute Specification and in Figs. 1-4 of Applicant's originally filed drawings.

In contrast to Applicant's Claim 7, the shield electrode 14 of Nakakubo et al., which the Examiner alleged corresponds to the terminal electrode recited in Applicant's Claim 7, is clearly **NOT** arranged to be directly connected to a land on a mother board via solder, and the connection electrode 16 of Nakakubo et al., which the Examiner alleged corresponds to the first conductor for appearance inspection recited in Claim 7, is clearly **NOT** arranged such that solder connecting a terminal electrode to a land on a mother board could or should extend from a terminal electrode onto the connection electrode 16 of Nakakubo et al.

In fact, Nakakubo et al. fails to teach or suggest anything at all about any specific connection between a terminal electrode and a land on a mother board, that solder could or should be used for such a connection, that a conductor for appearance inspection could or should be arranged such that the solder connecting the terminal electrode to the land on the mother board extends thereon, or that any advantages or benefits would or could have been obtained by such an arrangement.

Thus, Nakakubo et al. clearly fails to teach or suggest the features of "the terminal electrode is arranged to be directly connected to a land on a mother board via solder" and "the first conductor for appearance inspection is arranged such that the solder connecting the terminal electrode to the land extends from the terminal electrode onto the first conductor for appearance inspection" as recited in Applicant's Claim 7.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 7 under 35 U.S.C. § 102(b) as being anticipated by Nakakubo et al.

The Examiner relied upon Brown to allegedly cure deficiencies of Nakakubo et al. However, Brown fails to teach or suggest the features of "the terminal electrode is arranged to be directly connected to a land on a mother board via solder" and "the first conductor for appearance inspection is arranged such that the solder connecting the terminal electrode to the land extends from the terminal electrode onto the first conductor for appearance inspection" as recited in Applicant's Claim 7. Thus, Brown fails to cure the deficiencies of Nakakubo et al. described above.

Accordingly, Applicant respectfully submits that Nakakubo et al. and Brown, applied alone or in combination, fail to teach or suggest the unique combination and arrangement of features recited in Applicant's Claim 7.

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claim 7 is allowable. Claims 8-22 depend upon Claim 7, and are therefore allowable for at least the reasons that Claim 7 is allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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